

REMARKS

Applicants reply to the Office Action mailed on June 6, 2005, within the shortened statutory period for reply. Claims 1-46 are pending in the application and Applicants amend various claims to clarify antecedent basis and terminology. No new matter has been introduced by these amendments.

Claims 1-47 were pending and were objected to because of the following informalities: the individual claim numbers of all current claims are listed as "[c1]" ... "[c46]". Applicants respectfully traverse this rejection. Due to electronic filing of this application, the PTO software originally converted the claims to be listed as [c1] through [c46]. However, if the Examiner still believes that the claim numbering is inappropriate, Applicants respectfully request the Examiner to clarify the electronic filing requirements.

DOUBLE PATENTING

The Examiner provisionally rejects claims 1-7, 11-24, 26-29, 32-35, 37-40, 42 and 44-46 under the judicially created doctrine of double patenting over claims 1-7, 12-25, 27-30, 33-35, 38-41, 43, 45-47 respectively of copending Application No. 10/708,833 in view of Vatanen, U.S. Application No. 2002/0083320A1 ("Vatanen"). While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this nonstatutory double patenting rejection is based on the above-listed application, No. 10/708,833, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

Further, the Examiner asserts that "Vatanen discloses throughout, a identification circuit card which includes a comparison between collected DNA data and previously stored DNA data for authentication" and that using "DNA identification as taught by Vatanen in the system of the copending '833 claims...would provide a very specific biometric identification to a single user for optimal security" (page 3). Applicants respectfully traverse this rejection. Vatanen generally discloses a method and system for the application of a safety marking in electronic form for the

marking of devices ([0002]). Vatanen is limited to storing a DNA sample pertaining to a single in a safety marking attached to a device to use as evidence of ownership for that device ([0015]-[0016]). Because the '833 reference is now mooted by the filing of the terminal disclaimer, it no longer would be obvious to use "DNA identification as taught by Vatanen in the system of the copending '833 claims" (page 3). That is, Vatanen fails to disclose biometric DNA scan detection for facilitating payments. As such, Vatanen does not disclose or suggest at least "a verification device configured to verify said proffered DNA scan sample to facilitate a payment transaction," as similarly recited in independent claims 1, 22 and 34.

The Examiner objects to claims 8-10, 25, 30-31, 36, 41, 43 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for the indication of allowable subject matter in claims 8-10, 25, 30-31, 36, 41, 43. However, Applicants assert that independent claims 1, 22, and 34 are now allowable claims in view of the Terminal Disclaimer filed herewith. Claims 8-10, 25, 30-31, 36, 41, 43 variously depend from independent claims 1, 22, and 34, so claims 8-10, 25, 30-31, 36, 41, 43 are differentiated from the cited reference for the same reasons as set forth above, as well as in view of their own respective features.

CONCLUSION

Applicants respectfully submit that the pending claims are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

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